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EXAMINER

SHEEHAN, J

ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 28

Application Number: 08/637,802  
Filing Date: May 8, 1996  
Appellant(s): Eccles

Susan M. Keating  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**  
**JAN 16 2001**  
**GROUP 1700**

This is in response to appellant's brief on appeal filed November 16, 2000.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the

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pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1 to 4, 6 to 15 and 17 to 23 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

A substantially correct copy of appealed claims 1 to 4, 6 to 15 and 17 to 23 appears on pages 11 to 15 of the Appendix to the appellant's brief. The minor errors are as follows:

I. Claims 17 to 20 should read as:

17. A silver composition comprising:

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92.5 weight percent silver;  
2.35 weight percent copper;  
2.82 weight percent zinc;  
0.19 weight percent silicon;  
0.01 weight percent boron;  
0.23 weight percent indium; and  
1.9 weight percent germanium.

18. A silver composition comprising:

92.5 weight percent silver;  
3.25 weight percent copper;  
3.75 weight percent zinc;  
0.2 weight percent silicon;  
0.01 weight percent boron;  
0.25 weight percent indium; and  
0.04 weight percent germanium.

19. A silver composition comprising:

92.5 weight percent silver;  
3.0 weight percent copper;  
3.14 weight percent zinc;  
0.15 weight percent silicon;

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0.01 weight percent boron;  
0.2 weight percent indium; and  
1.0 weight percent germanium.

20. A silver composition comprising:

2.25 weight percent zinc;  
0.075 weight percent indium;  
0.075 weight percent tin;  
0.125 weight percent germanium;  
0.003 weight percent boron;  
0.20 weight percent silicon;  
4.772 weight percent copper; and  
92.5 weight silver.

II. In claim 22, line 3, "born" should read --boron--.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

|  |                 |         |
|--|-----------------|---------|
| 5,039,479                                    | Bernhard et al. | 8-1991  |
| 2,255,348 (Great Britain<br>Patent Document) | Rateau          | 11-1992 |

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**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1 to 4, 6 to 15 and 17 to 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over **Bernard et al. '479** taken in view of **Rateau et al.** (Great Britain patent document 2,255,348).

Bernard et al. '479 teaches reduced fire scale silver-copper alloys (column 2, lines 24 to 34) consisting essentially of, in weight percent,

|         |               |
|---------|---------------|
| silver  | 89.3 to 93.5% |
| copper  | 0.5 to 6%     |
| zinc    | 0.5 to 5%     |
| silicon | 0.1 to 2%     |
| boron   | 0.001 to 2%   |
| tin     | 0.25 to 2%    |
| indium  | 0.01 to 1.25. |

This alloy is made by alloying silver metal with a master alloy (column 2, lines 34 to 37) consisting essentially of, in weight percent,

|         |                |
|---------|----------------|
| silicon | 0.9 to 30.7%   |
| boron   | 0.001 to 30.7% |
| zinc    | 4.5 to 76.9%   |
| copper  | 4.5 to 92.3%   |

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|        |                |
|--------|----------------|
| tin    | 2.2 to 30.7%   |
| indium | 0.09 to 19.2%. |

Rateau et al. teach that adding 0.5 to 3 % weight germanium to a silver-copper alloy (page 3, lines 2 to 4) improves the hardness of the silver-copper alloy (see, for example, page 5, lines 11 to 13, page 6, Table II, Alloys 3 and 4).

The claims and Bernard et al. '479 differ in that Bernard et al. '479 do not teach the exact proportions for each of the alloy components nor does Bernard et al. '479 teach the use of Germanium.

However, one of ordinary skill in the art at the time the invention was made would have been motivated to add Germanium to Bernard et al. '479's alloy so as to improve the hardness of the resulting alloy as taught by Rateau et al.

**(11) Response to Argument**

**Appellant's Reoccurring Points of Arguments**

Prior to addressing each of appellant's arguments the Examiner would like to make the following comments.

Throughout the brief appellant state that the instantly claimed alloy possesses "superior fire scale resistance, improved work hardenability, excellent cast hardening and long fluidity ranges" over known silver alloys (for example, brief, page 2, third full paragraph; page 3, first paragraph under argument; page 4, second, third and fourth full paragraphs). However,

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appellant has not submitted or cited any objective evidence to substantiate these allegations. In view of this lack of supporting evidence it is the Examiner's position that "[i]t is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements in the specification do not suffice." In re Deblauwe, 222 USPQ 191, 196 (Fed. Cir. 1984). Mere lawyer's arguments and conclusory statements in the specification, unsupported by objective evidence, are insufficient to establish unexpected results.", In re Wood, Whittaker, Stirling and Ohta, 199 USPQ 137, 140 (CCPA 1978).

Appellant also repeatedly refers to the instantly claimed germanium content as "trace amounts" (for example, brief page 4, line 4 and last line) while urging that "Rateau teaches only the use of large quantities of germanium". It should be pointed out that the amount of germanium recited in the instant claims and the amount of germanium taught by Rateau are not disparate as appellant's arguments imply. The instant claims recite a germanium content of "0.01-2.5% by weight germanium" (claim 1, penultimate line) while Rateau teaches a germanium content of "0.5 to 3.0% by weight" (page 3, lines 3 and 4). Thus there is considerable overlap between the instantly claimed germanium content and the germanium content taught by Rateau.

The Examiner's comments set forth above regarding certain points of appellant's brief are made at the beginning of the Examiner's response in that appellant repeats these points throughout the brief. Rather than repeatedly responding to these same points the Examiner has addressed appellant's points once and for all above and requests that the members of the Board



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please keep in mind the above comments by the Examiner throughout their reading of appellant's brief.

### **The Examiner's Response to Appellant's other Arguments**

Appellant argues that Rateau is limited to improving the fire scale resistance of silver-copper alloys by adding germanium to a silver-copper alloy and does not teach the addition of germanium to a complex silver alloy containing metals and non-metals. This argument is not persuasive. Rateau does, in fact, teach that the addition of germanium improves fire scale resistance (page 4, line 3) and hardness while maintaining ductility (page 5, lines 11 to 13) of silver-copper alloys. There is no reason to believe nor has appellant advanced any reasons to believe that the addition of germanium as taught by Rateau would not improve the fire scale resistance and hardness while maintaining ductility of other Ag-Cu based alloys such as Bernard's silver-copper alloy.

Appellant argues that, "The Examiner cannot disregard the claimed invention as a whole, which is a complex silver alloy composition comprised of metals and non-metals exhibiting superior fire scale resistance, increased work hardenability over known fire scale resistance alloys, excellent cast hardness and expanded fluidity range". This is not persuasive. Appellant has not submitted or cited any objective evidence to substantiate the allegations of superior and improved properties. In view of this lack of supporting evidence it is the Examiner's position that "[i]t is well settled that unexpected results must be established by factual evidence. Mere

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argument or conclusory statements in the specification do not suffice." In re Deblauwe, 222 USPQ 191, 196 (Fed. Cir. 1984). Mere lawyer's arguments and conclusory statements in the specification, unsupported by objective evidence, are insufficient to establish unexpected results." In re Wood, Whittaker, Stirling and Ohta, 199 USPQ 137, 140 (CCPA 1978).

Appellant argues "That, it is well known that the addition of an alloying element to a base metal composition containing other additives, some non-metals and some metalloid that behave as non-metals may not necessarily have the same result as the addition of the same alloying metal to the base metal alone without additives" (brief, page 5). Appellant goes on to argue that in view of this, the addition of germanium to Rateau's silver-copper alloy does not predict the behavior in more complex silver alloys. The Examiner is not persuaded. First, appellant, has done nothing to establish that his above quoted allegation is, in fact, "well known". Thus any arguments based on appellant's allegation carry little, if any, weight. Second, as set forth above by the Examiner, *in the statements of the rules* Rateau does, in fact, teach that the addition of germanium improves fire-scale-resistance (page 4, line 3) and hardness while maintaining ductility (page 5, lines 11 to 13) of silver-copper alloys.

There is no reason to believe nor has appellant advanced any reasons to believe that the addition of germanium as taught by Rateau would not improve the fire scale resistance and hardness while maintaining ductility of other silver-copper based alloys such as Bernard's silver-copper alloy. In making this argument appellant refers to the attached Declaration of Melvin Bernard (brief, page 6, line. However, appellant has not directed the Examiner's nor the Board's attention to any specific

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section of the Bernard Declaration nor can the Examiner find a section of Bernard's declaration which addresses this issue.

Appellant, citing Rateau, page 3, lines 27 to 29, argues that Rateau teaches away from the use of silicon, teaches the use of germanium as a replacement for silicon (brief, page 6, first full paragraph). The Examiner is not persuaded. The passage in Rateau cited by appellant does not teach away from nor preclude the use of silicon or the use of silicon in combination with germanium. The cited passage merely states the differing effects of silicon and germanium in silver-copper alloys. Actually, in view of the fact that silicon causes silver-copper alloys to be "brittle to varying degrees", this passage would encourage one to add germanium to silver-copper alloys since germanium "ensures that the alloy does not become brittle" (Rateau, page 3, lines 26 and 29).

**Declaration under 37 CFR 1.132 by Melvin Bernard Attached to Appellant's Brief**

Appellant, relying on the declaration under 37 CFR 1.132 by Melvin Bernard attached to appellant's brief, presents arguments of commercial success. Appellant's arguments parallel the statements made in the Bernard declaration attached to appellant's brief, therefore the following Examiner's comments which are directed to the Bernard declaration are equally applicable to the appellant's arguments set forth in the brief.

For the following reasons the Examiner considers the declaration under 37 CFR 1.132 by Mr. Melvin Bernard filed November 6, 2000 with the brief to be insufficient.

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I. Appellant acknowledges that the evidence of alleged commercial success is directed to the alloy recited in dependent claim 7 (brief, page 6, last paragraph). Thus, at best, the evidence of alleged commercial success is directed to the invention recited in claim 7 and claims 8 and 14 which depend from claim 7. Further, since the evidence of alleged commercial success is directed to the alloy of claim dependent 7, the evidence is not commensurate in scope to the remaining claims, MPEP 716.03(a), the first paragraph. Accordingly, the declaration has no bearing on claims 1 to 4, 6, 8 to 13, 15 and 17 to 23.

II. The declaration shows the sales figures for the “Apecs sterling silver alloy” sterling silver alloy” for the years 1994 to 1999. However, the declaration does not show the market share that the “Apecs sterling silver alloy” held for the years for which sales figures are given, 1994 to 1999. Absent market share gross sales do not show commercial success, MPEP 716.03(b) last paragraph.

III. The declaration is silent as to market position of United Precious Metal Refining Co., Inc. (which is the sole licensee of the “Apecs sterling silver alloy” sterling silver alloy”) prior to the introduction of “Apecs sterling silver alloy” sterling silver alloy”, MPEP 716.03(b) third paragraph. The alleged success of the “Apecs sterling silver alloy” may be the result of the market position of United Precious Metal Refining Co., Inc. rather than the features of the claimed alloy.

IV. The declaration does not demonstrate that the alleged commercial success is derived from the claimed invention. The declaration alleges that the increase in sales is due to the characteristics of the alloy and that customers have stated that they have chosen “Apecs sterling

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silver alloy” because of the improved properties (declaration page 5, first full paragraph). However neither of these allegations are substantiated in any manner. With respect to the customers’ comments it is the Examiner’s position that this is purely unsubstantiated here say. Appellant’s opinion as to the purchaser’s reason for purchasing the claimed invention is insufficient to demonstrate commercial success, MPEP 716.03(b), second paragraph. Appellant has not established that the alleged commercial success is directly related to the merits of the claimed invention and not the result of extraneous business events and that the claimed features were responsible for the alleged commercial, MPEP 716.03(b), first, second and third paragraphs.

**Additional Declarations under 37 CFR 1.132**

It is noted that additional declaration under 37 CFR 1.132 have been submitted throughout the course of prosecution of the instant application. Although appellant did not discuss these additional declarations in the brief but rather only mentioned them in passing (brief, page 7, lines 3 to 5) the Examiner will incorporate his comments regarding each of these declarations below.

**Declaration by Mr. Anthony Phillip Eccles under 37 CFR 1.132 filed September 16, 1998**

The declaration by Mr. Anthony Phillip Eccles under 37 CFR 1.132 filed September 16, 1998 (Paper No. 13) is insufficient to overcome the rejection of claims 1 to 4, 6 to 15 and 17 to 23 based upon Bernard et al. ‘479 taken in view of Rateau et al. because:

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I. There is no nexus between “the “Apecs sterling silver alloy” silver alloy” referred to in the declaration and the alloy composition recited in the instant claims, that is, there is no indication that “the “Apecs sterling silver alloy” silver alloy” is actually the alloy recited in the instant claims, MPEP 716.03(a).

II. With respect to the long felt need section of the declaration, there is no objective evidence to support Mr. Eccles’ allegation that a long felt need existed, MPEP 716.04. The statement that United Precious Metals “had an interest and desire” to develop the instant invention is an opinion which is unsubstantiated with any factual evidence, MPEP 716.01(c).

III. The declaration state(s) that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no showing that persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references and still were unable to solve the problem. See MPEP §716.04.

IV. With respect to the commercial success section of the declaration there is no objective evidence to support Mr. Eccles’ allegations that the instantly claimed alloy was a commercial success, MPEP 716.04.

V. Further, it is noted that the applicant, Mr. Anthony Phillip Eccles, who signed this declaration is not employed by United Precious Metals and there is nothing in the record that gives Mr. Eccles the authority to speak for United Precious Metals regarding United Precious

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Metals' opinions regarding the long felt need and the commercial success of the instantly claimed alloy.

**Declaration by Melvin Bernard under 37 CFR 1.132 filed December 16, 1998**

The declaration by Melvin Bernard under 37 CFR 1.132 filed December 16., 1998 (Paper No. 19) is insufficient to overcome the rejection of claims 1 to 4, 6 to 15 and 17 to 23 based upon Bernard et al. '479 taken in view of Rateau et al. because:

I. The declaration state(s) that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no showing that persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references and still were unable to solve the problem. See MPEP §716.04.

II. In the first line on page 2 of the declaration, United Precious Metal is described as "the licensee" of the instant patent application. The Examiner questions whether United Precious Metal is the only licensee of the instant application or whether United Precious Metal is the exclusive licensee of the instant application. In order to fully evaluate Mr. Bernard's declaration it is essential that the Examiner be made completely aware of whether United Precious Metal is the only licensee of the instant application or whether United Precious Metal is the exclusive licensee of the instant application so that it is apparent what Mr. Bernard's direct or indirect interest is in the instant application.

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III. There is not a consistent nexus between the instantly claimed alloy composition and the silver alloy(s) discussed in the declaration. On page 4 of the declaration the instantly claimed alloy composition is listed. It is stated that, "This new silver alloy is referred to further in this declaration as the "'Apecs sterling silver alloy" Silver Alloy'." However, this exact phrase, "Apecs sterling silver alloy" Silver Alloy, does not appear in the declaration again. Instead, variants of the phrase are used, for example, "[t]his new "Apecs sterling silver alloy" silver alloy" (page 4, last paragraph, last sentence), "present invention" (page 5, line 3), "claimed invention" (page 5, last paragraph, first line), "claimed invention" (page 6, line 1 and paragraph 2, line 1) and "'Apecs sterling silver alloy" silver alloy" (page 6, lines 9, 13, 15 and 20). In view of the use of these various terms and not the consistent use of the term "'Apecs sterling silver alloy" Silver Alloy" it is not clear that Mr. Bernard is actually referring to the "'Apecs sterling silver alloy" Silver Alloy" as defined on page 4 of the declaration which definition is the same alloy as the instantly claimed alloy, MPEP 716.03(a).

III. Much of the declaration is Mr. Bernard's opinions, for example:

- "The silver alloys of the claimed invention have enjoyed a wide degree of acceptability for their silver color,...and other fine silver application" (page 2, paragraph 1, the last sentence)
- "In my opinion" (page 5, last paragraph; page 6, paragraphs 1, 3 and 4)
- The statements made on page 6, paragraph 2.

However, there is no probative evidence to support Mr. Bernard's opinions, MPEP 716.01(c).



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**“Declaration” by Melvin Bernard under 37 CFR 1.132 filed September 2, 1999**

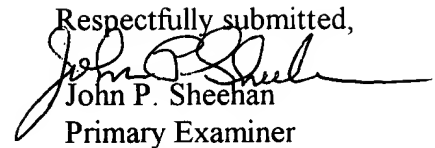
In the brief appellant refers to a declaration by Melvin Bernard submitted September 2, 1999 (brief page 7, line 5). It is noted that no new declaration by Melvin Bernard was submitted in September 1999. Instead, in the response submitted September 7, 1999 (Paper No. 22) appellant attempted to amend Melvin Bernard’s earlier declaration submitted December 16, 1998 (Paper No. 19).

With respect to the proposed amendments to Melvin. Bernard’s declaration it is the Examiner’s position that the proposed amendments to Melvin Bernard’s declaration should not be entered in that a declaration is a document that is sworn to by the declarant. The proposed changes to Mr. Bernard’s declaration have not been sworn to by Mr. Bernhard. Further, the Examiner could not find a provision in either the Rules or the MPEP for amending a declaration submitted under 37 CFR 1.132. The Examiner indicated to the appellant that if the appellant disagreed with the Examiner’s non-entry of the proposed amendments to Mr. Bernard’s declaration then appellant is requested to cite the Rule or the MPEP section on which they are relying in attempting to amend Mr. Bernard’s declaration. Appellant never responded to the Examiner’s request. Accordingly, the proposed amendments to Mr. Bernard’s original declaration under 37 CFR 1.132 submitted December 16, 1998 (Paper No. 19) are considered improper and accordingly have not been considered by the Examiner.


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For the above reasons, it is believed that the rejections should be sustained.

John P. Sheehan  
January 11, 2001

Respectfully submitted,  
  
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Primary Examiner  
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